

REMARKS

In the Office Action¹ mailed April 14, 2009, the Examiner rejected claims 4 and 5 under 35 U.S.C. § 112, second paragraph; rejected claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by Ootsubo et al. (U.S. Publication No. 2003/0087297, hereafter "Ootsubo"); rejected claims 1-2 and 4 under 35 U.S.C. § 102(b) as being anticipated by Hashimoto (U.S. Publication No. 2001/0024788, hereafter "Hashimoto"); and rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Phan (U.S. Patent No. 5,434,423, hereafter "Phan").

By this amendment, Applicants cancel claim 4, without prejudice or disclaimer, and amend claims 1, 3, and 5. Support for the claim amendments can be found in the Specification at, for example, page 11, line 4 to page 12, line 6. Claims 1-3 and 5 remain pending and under consideration.

Applicants respectfully traverse the rejection of claims 4 and 5 under 35 U.S.C. § 112, second paragraph. However, to advance the prosecution of this application, Applicants have canceled claim 4 and amended claim 5. Accordingly, Applicants respectfully request withdrawal of rejection of claims 4 and 5 under 35 U.S.C. § 112, second paragraph.

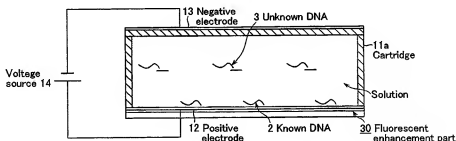
Applicants respectfully traverse the rejection of claims 1-4 under 35 U.S.C. § 102(b) as being anticipated by Ootsubo.

¹ The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1, as amended, recites an apparatus for analyzing biochemical reaction using a substrate, the apparatus comprising, among other things, "an external electrode disposed opposite to [an] electrode of the substrate, the external electrode having a probe shape," (emphasis added). Ootsubo fails to teach or suggest at least the external electrode having a probe shape.

Ootsubo, at paragraph [0024], states, "[i]n FIG. 4, . . . negative electrode 13 is constructed in a detachable manner and is mounted on the upper surface of cartridge 11a." As evident from Figure 4 of Ootsubo, reproduced below, Ootsubo merely discloses that negative electrode 13 is flat. Ootsubo does not disclose that negative electrode 13 has a probe shape. Accordingly, Ootsubo fails to teach or suggest, "the external electrode having a probe shape," as recited in amended claim 1. Therefore, claim 1 is distinguishable over Ootsubo.

FIG.4



Claims 2 and 3 depend from claim 1, and require all the elements of claim 1. Accordingly, claims 2 and 3 are distinguishable over Ootsubo at least due to their dependence.

Applicants have canceled claim 4. Accordingly, the rejection of claim 4 under 35 U.S.C. § 102(b) as being anticipated by Ootsubo is moot.

Applicants respectfully traverse the rejection of claims 1-2 and 4 under 35 U.S.C. § 102(b) as being anticipated by Hashimoto.

Hashimoto, at paragraph [0063], states, “solutions of 30-mer oligonucleotides 5 each of which has a different sequence are respectively, dripped onto the electrode regions 2 of the electrode substrate shown in FIG. 1, thereby to produce a first electrode substrate 4 [shown in FIG. 2] which has a first nucleic acid strand 5 used as a template for synthesizing a second nucleic acid strand (i.e., a probe).” As evident from Figure 2 of Hashimoto, reproduced below, Hashimoto merely discloses that first electrode substrate 4 is flat. Hashimoto does not disclose that first electrode substrate 4 has a probe shape. Accordingly, Hashimoto fails to teach or suggest, “the external electrode having a probe shape,” as recited in amended claim 1. Therefore, claim 1 is distinguishable over Hashimoto.

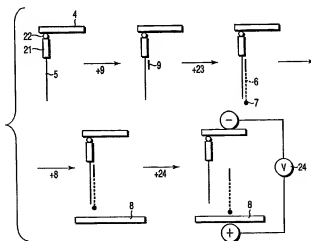


FIG. 2

Claim 2 depends from claim 1 and requires all the elements of claim 1.

Accordingly, claim 2 is distinguishable over Ootsubo at least due to its dependence.

Applicants have canceled claim 4. Accordingly, the rejection of claim 4 under 35 U.S.C. § 102(b) as being anticipated by Hashimoto is moot.

Applicants respectfully traverse the rejection of claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Hashimoto in view of Phan.

Claim 5 depends from claim 1, and requires all the elements of claim 1. The Examiner cited Phan as allegedly disclosing subject matter recited only in claim 5. Accordingly, Phan fails to cure the deficiencies of Hashimoto. For at least this reason, claim 5 is distinguishable over Hashimoto and Phan.

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 9, 2009

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